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Farrukh S. Najmi

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SUN MICROSYSTEMS, INC. c/o DORSEY & WHITNEY, LLP  
370 SEVENTEENTH ST.  
SUITE 4700  
DENVER, CO 80202

EXAMINER

APPLE, KIRSTEN SACHWITZ

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/774,451

Applicant(s)

NAJMI, FARRUKH S.

Examiner

Kirsten S. Apple

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,10-16,19-23 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10-16,19-23 and 28-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## Detailed Action

This action is in response to the application response filed on September 6, 2007.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 34 Examiner finds these claims to lack concrete result as well as a tangible result. Examiner notes that the focus of this analysis is on the result, not the individual steps.

With respect to a tangible result, the process must produce a real-world result. All three steps involve "arranging" - is this done in someone's head or on the telephone.

Corrective action to claims is required.

### *Claim Rejections - 35 USC § 103*

The Examiner has read and reviewed all of the information provided by the Applicant.

The examiner rejects as final claims 1, 2, 5-7, 10-16, 19-23 and 28-34 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-7, 10-16, 19-23 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandler (US Patent 5,732,400) in view of Bhatt (US Patent 6,405,191).

**With regard to Claims 1, 16, 22** Mandler teaches a buyer/seller/broker intermediary system & method wherein buyers place Request for Quotes (FRQ) with a broker who then forwards the information to a plurality of sellers for consideration and response. See (Col. 3, lines 48-58). Mandler does not expressly teach the publish/subscribe system & method described by the Applicant, however this is an old and well-known process exemplified by Bhatt. Bhatt discloses the following:

subscribing to a service interface by the certain one of the first plurality of e-business entities operating on a plurality of enterprise communication system protocols;  
(Col. 5, lines 48-52)

wherein the service interface contains a list of second plurality of e-business entities  
(Col. 3, lines 6-15; Col. 14, lines 6-45)

and wherein a subscription is created which is in communication with a broker via a query manager interface (Col. 14, lines 6-45)

publishing the message to the broker by the first entity, the broker being in communication with the service interface via the query manager interface;  
(Col. 2, line 64 – Col. 3, line 5; Col. 14, lines 6-45)

determining the selected ones of the plurality of e-business entities to receive the message by the broker; and  
(Col. 3, line 66 – Col. 4, line 3)

publishing the message to the selected ones of the plurality of entities based upon the determining. (Col. 11, lines 56-66)

multicasting the message to the selected ones of the plurality of e-business entities based upon the determining by the broker, such that the first entity is not required to know any one of the plurality of enterprise computer system protocols.  
(Col. 11, lines 56-66)

Also, for each of the six (6) limitations above, see generally (Bhatt, Claims 1-2).

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to a publish/subscribe method. The motivation for such a combination can be found in both references. In Bhatt, the use of the publish/subscribe system is contemplated for the electronic commerce arts at (Bhatt, Col. 1, lines 24-28), which describes how the nature of business events triggers the system. More importantly, however, Mandler suggest using improved computer technologies at (Col.2, line 65 – Col. 3, line 29) to reduce distribution cost, expand markets for sellers, and allowing buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

Mandler teaches the system & method comprising:

receiving the message through a multicast protocol at each of the selected ones of the plurality of entities; (Col. 4, lines 25-29)

reviewing the message at each of the selected ones of the plurality of entities;

(Col. 4, lines 29-31, which implicitly contains a review of the RFQ) and

determining if a response to the message is to be generated at each of the selected ones of the plurality of e-business entities based upon the reviewing.  
(Col. 4, lines 29-31)

Mandler teaches the system & method comprising:

publishing the response to the service interface based upon the determining;  
(Col. 4, lines 29-31)

publishing the response to the broker by the service interface; and  
(Col. 4, lines 29-31)

publishing the response to the first entity by the broker.  
(Col. 4, lines 29-31)

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Bhat relating to a publish/subscribe method with the teachings of Mandler providing for the review of incoming messages and the response thereto. The motivation for such a combination can be found in both references. In Bhatt, the use of the publish/subscribe system is contemplated for the electronic commerce arts at (Bhatt, Col. 1, lines 24-28), which describes how the nature of business events triggers the system. As well, Mandler suggest using improved computer technologies at (Mandler, Col.2, line 65 – Col. 3, line 12). An obvious business application is to publish responses to the RFQ's so as to consummate a transaction.

**With regard to Claims 2, 21, 23** in terms of initial limitation, as well as the last limitation, comprising:

setting an expiration time for the published message after receiving the published message from the first entity;

purging the message when the expiration period lapses.

the Examiner observes that an expiration time is an inherent aspect of publish/subscribe system and method. Bhatt and Mandler do not expressly teach this limitation, however it would be considered part of the teachings of Mandler/Bhatt combination. Bhatt does disclose the remaining two limitations:

retaining the published message;  
(Col. 11, lines 62-66)

determining if an appropriate one of the plurality of entities has subsequently subscribed to the service interface so as to be identified to receive the message;

(Col. 12, lines 2-8)

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to sorting out new subscriber/sellers. The motivation for such a combination can be found in both references. In Bhatt, the use of the publish/subscribe system is contemplated for the electronic commerce arts at (Bhatt, Col. 1, lines 24-28), which describes how the nature of business events triggers the system. More importantly, however, Mandler suggest using improved computer technologies at (Col.2, line 65 – Col. 3, line 29) to reduce distribution cost, expand markets for sellers, and allowing buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

**With regard to Claim 5** Mandler nor Bhat teach the method wherein:

the responding ones of the plurality of entities are each anonymous to the first entity.

The examiner takes Official Notice that anonymous publishing is old and well known in the art, and is a common occurrence in a publish/subscribe scenario. Therefore, it would have been obvious to one of ordinary skill in the art modify the teachings of Mandler to expressly include anonymous publishing. The motivation for such a combination is to expand the number of applications available to users of the system. Applicant has not traversed the noticed fact in Claims 5 and 26, and pursuant to MPEP §214.03(C), the Examiner considers as admitted prior art, the elements of Claims 5,26.

**With regard to Claim 6**, Mandler does not teaches the method comprising:

publishing the response directly to the first entity based upon the determining.

However, once the seller knows the identity of the buyer, an inherent part of the system is that the seller can then either continue to process the RFQ using the broker, OR if so inclined, initiate communication with the buyer directly. Mandler thus anticipates this claim as well.

**With regard to Claim 7** Mandler specifically emphasizes that buyers and sellers need not have previously conducted business together. Even so, there is nothing in the disclosure that indicates the buyer or seller can not know each other. Thus inherent to the system is the idea that in some cases, the responding ones of the plurality of entities are each known to the first entity.

**With regard to Claims 10,19,28** Mandler teaches a system and method wherein:

the message is a request for a quote (RFQ).  
(Col. 7, lines 21-27)

**With regard to Claims 11,20,29** Mandler teaches a system and method wherein:

the response is a quote.  
(Col. 7, lines 39-40)

**With regard to Claim 12,30** Mandler teaches a method wherein:

the first entity is included in a first enterprise computer system and wherein at least one of the responding entities is included in a second enterprise computing system.  
(Col. 6, lines 22-40)

**With regard to Claim 13,31** Mandler teaches a method wherein:



the first and the second enterprise computing systems are different enterprise computing systems.  
(Col. 6, lines 40-43)

**With regard to Claim 14,32** Mandler does not expressly teaches a method wherein:

the first enterprise computing systems is an ebXML based enterprise computing system.

However, the examiner observes that unless the use of a specific operating system or programming language is *critical or uniquely required* for implementation of the claimed method, very little patentable weight is given to claims identifying one operating system or programming language.

Even so, the examiner observes that ebXML is more or less a framework for developing a business transaction vocabulary that is based on XML. Bhatt teaches using XML in its operation of a publish/subscribe system at (Col. 3, lines 50-57). As such, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to a publish/subscribe method based on XML. The motivation for such a combination is found in Mandler at (Col.2, line 65 – Col. 3, line 29) which suggests using improved computer technologies to reduce distribution cost, expand markets for sellers, and allow buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

**With regard to Claim 15,33** Mandler does not expressly teach the method wherein:

the second enterprise computing systems is an ebXML based enterprise computing system.

However, the examiner observes that unless the use of a specific operating system or programming language is *critical or uniquely required* for implementation of the claimed

method, very little patentable weight is given to claims identifying one operating system or programming language.

Even so, the examiner observes that ebXML is more or less a framework for developing a business transaction vocabulary that is based on XML. Bhatt teaches using XML in its operation of a publish/subscribe system at (Col. 3, lines 50-57). As such, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Mandler, relating to a broker/intermediary between buyers and sellers, with the teachings of Bhat relating to a publish/subscribe method based on XML. The motivation for such a combination is found in Mandler at (Col.2, line 65 – Col. 3, line 29) which suggests using improved computer technologies to reduce distribution cost, expand markets for sellers, and allow buyers to price shop among sellers via electronic commerce for optimal price and selection of goods.

**With regard to Claims 34 Mandler claims:**

Receiving a message of second e-business entity and Generating and publishing a response (Col. 7, lines 21-27)

***Response to Arguments***

Applicant's arguments filed September 6, 2007 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1<sup>st</sup>: Mandler, only the buyer are registered not the sellers.

The Examiner refutes the argument made by the Applicant and draws the attention to Mandler and draws the attention to the last line of the abstract explaining that the system can also

include a broker coupled... between buyer and seller. It is therefore the interpretation of the examiner that this is intended to be a hub system for both buyers and sellers.

Applicants argued 2<sup>nd</sup>, with respect to claims 2, 21 & 23 examiner improperly relies on the theory of inherency. The office action asserts that "an expiration of time is an inherent aspect of a publish.subscribe system"

The Examiner refutes the argument made by the Applicant and draws the attention to Mandler Figure 4A-1 Item S15.1 "pending" states where the broker waits. It is inherent in the word "wait" that there is a time limit associated with it otherwise the flow chart would stop. Even if Figure 4A-1 did not exist it is clear "official notice" that a registry service would include "time limits" within the business rules.

Applicants argued 3<sup>rd</sup>, with respect to claim 6 the examiner improperly relies on the theory of inherency. The office action asserts that "an inherent part of the system is that the seller can either continue to process the RFQ .. or initiate communication with buyer directly:

The Examiner refutes the argument made by the Applicant and draws the attention to Mandler, column 4 line 5-6 reiterates that the buyer can go thru the broker or direct.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa



**MARY D. CHEUNG**  
**PRIMARY EXAMINER**